

PATENT
Attorney Docket No. **UM-06102**

REMARKS

Claims 1-90 were originally filed in the present case and are subject to an election requirement. Claims 23-91 have been amended to correct a mis-numbering of the claims. Thus, the present Claims are Claims 1-91. In the Office Action dated 9/11/03, the Examiner required two specie elections. In a telephone interview with the Examiner on 10/2/03, it was agreed that the description of specie D should be reworded to state that it is directed to embodiments which do not require a display of a first physical property regarding protein separation separate from mass spectrometry analysis (Interview summary dated 10/2/03).

The elected Claims are thus 33, 35-39, 45-49, 51-54, 59-70, 72-82, and 88-91.

Applicants note that all amendments, cancellations, and additions of Claims presented herein are made without acquiescing to any of the Examiner's arguments or rejections, and solely for the purpose of expediting the patent application process in a manner consistent with the PTO's Patent Business Goals (PBG),¹ and without waiving the right to prosecute the cancelled claims (or similar claims) in the future.

In the office action dated 9/11/03, the Examiner made a number of rejections. The rejections are listed below in the order in which they are herein addressed.

- (1) Claims 33, 35, 36, 38, 39, 45-49, 51, 53 and 54 are rejected under 35 U.S.C. 112, first paragraph, as allegedly lacking enablement;
- (2) Claims 33, 35-39, 45-49, 51-54, 69-70 and 80-82 are rejected under 35 U.S.C. 112, second paragraph, as allegedly being indefinite; and
- (3) Claims 59-67, 69, 72-75, 77, 79-81, and 88-89 are rejected under 35 U.S.C. 103 (a) as allegedly being obvious in light of Jindal et al. (U.S. Patent 6,358,692; hereinafter Jindal).

I. The Claims are Enabled

¹ 65 Fed. Reg. 54603 (Sept., 8, 2000).

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The Examiner has rejected Claims 33, 35, 36, 38, 39, 45-49, 51, 53 and 54 under 35 U.S.C. 112, first paragraph, as allegedly lacking enablement (Office Action, pg. 3). The applicants respectfully disagree. In particular, the Examiner states "the specification, while being enabling for the practice of utilizing isoelectric focusing for obtaining fractions defined by a distinct pH range, does not reasonably provide enablement for generic non-limited pH range fractionation." (Office Action, pg. 3). The Applicants respectfully disagree and submit that the claims are enabled. However, in order to further the business interests of the Applicants and while reserving the right to prosecute the original (or similar) claims in the future, the Applicants have amended independent Claims 33 and 49 to specify the use of isoelectric focusing as the first separation method. As such, the applicants respectfully request that the rejection be withdrawn.

II. The Claims are Definite

The Examiner has rejected Claims 33, 35-39, 45-49, 51-54, 69-70 and 80-82 under 35 U.S.C. 112, second paragraph, as allegedly being indefinite (Office Action, pg. 4). In particular, the examiner states "Claims 33 etc. are vague and indefinite due to containing an abbreviation without a full name therewith, such as HPLC, ESI or TOF." And "Claims 39, 53, 70, and 82 contain the phrase "ESI oa TOF" which is vague and indefinite as to what is meant by "oa"."
(Office Action, pg. 4). The Applicants respectfully disagree and submit that the claims are definite as written. However, in order to further the business interests of the Applicants and while reserving the right to prosecute the original (or similar) claims in the future, the Applicants have amended the claims to provide the full names of the above-mentioned abbreviations. As such, the rejection is moot.

III. The Claims are Novel

The Examiner has rejected Claims 59-67, 69, 72-75, 77, 79-81, and 88-89 under 35 U.S.C. 103 (a) as allegedly being obvious in light of Jindal. The Applicants respectfully disagree. Nonetheless, in order to further the business interests of the Applicants and while reserving the right to prosecute the original (or similar) claims in the future, the Applicants have amended the claims. The amended claims incorporate the elements of 68 and 78, which the

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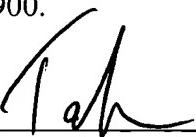
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Examiner has indicated are allowable (Office Action, pg. 6). As such, the Applicants respectfully request that the claims be passed to allowance.

CONCLUSION

If a telephone interview would aid in the prosecution of this application, the Examiner is encouraged to call the undersigned collect at (618) 218-6900.

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